

REMARKS

Claim 49 is added, and claim 47 is canceled without prejudice and therefore claims 22 to 46 and 49 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claim 27 is rewritten without prejudice to correct a minor clerical error.

Claim 47 was objected to under 37 C.F.R. 1.75(d)(1) as lacking proper antecedent basis (*see* Office Action, paragraph 3). Furthermore, claim 47 was rejected under the first paragraph of 35 U.S.C. § 112 as to the written description requirement (*see id.*, paragraphs 4 and 5). While the objection or rejection of claim 47 may not be agreed with, to facilitate matters, claim 47 is canceled without prejudice.

Claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado et al. U.S. Patent No. 7,051,005 (Peinado) in view of Serkowski U.S. Patent No. 6,513,121 (Serkowski).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there may be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination may be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 22, as presented, relates to a data transmission method, and includes the

features of transmitting first data to a first processor, transmitting second data to a second processor, the second data being based on the first data, checking the second data in the second processor to determine if the first data may be processed in the first processor, transmitting a check result to the first processor, the check result being a positive or a negative check result, responsive to receiving a positive check result, processing the first data at the first processor. The Office Action admits that Peinado does not disclose the feature of transmitting a check result to the first processor when the result is negative (*see* Office Action, page 4, lines 9 to 11), but relies on Serkowski as assertedly disclosing the feature.

As to claim 22, the Office Action does not provide any proper teaching or suggestion so as to combine Peinado and Serkowski, but relies on conclusory assertions. For example, page 4, lines 15 to 17 of the Office Action, conclusorily asserts that “[a]t the time of the invention it would have been obvious to a person of ordinary skill in the art to send both positive and negative check results in the Peinado et al. system”, and the Office Action also conclusorily asserts that “[m]otivation as recognized by one of ordinary skill in the art to do so would have been to notify the requestor that the requestor that the request has been denied”, which is the result of the claimed feature. It does not provide any “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as required by the *KSR* court.

Furthermore, the combination of Peinado with Serkowski does not disclose or suggest each and every feature in claim 22. As previously explained, Peinado does not identically disclose (nor even suggest) the feature of *transmitting a check result to the first processor, the check result being a positive or a negative check result*, as provided for in the context of claim 22. The Peinado assertion that “information sent from the license server tells the first processor that i[t] has permission to process the data using the information,” and that “[t]he refusal to send this information is an indication that the check has failed and the first processor does not have permission,” does not identically disclose (or even suggest) the feature of transmitting a check result from the second processor to the first processor as an affirmative indicator.

The check result has the characteristic being positive (permission to act) or negative (prohibition to act). When a positive check result is transmitted to the first processor, the first processor has permission to process the first data (*see* Substitute Specification at page 15, lines 15-23). When the conclusion from the check process indicates

that the first processor must not be used, an indicator of “prohibition against use of the first data is transmitted to the first processor by the second processor” (*see id.* at page 14, lines 30-34). After receiving the prohibition from the second processor, the first processor may take the action to delete the first data (*see id.*, page 14, line 35–page 15, line 1).

In contrast, the mere refusal to send a license in Peinado does not disclose the affirmative act of transmitting an indicative check result from the second processor to the first processor because without an indicator that the check result is a prohibition. The first processor waits for a check result and is unable to take any action such as deleting the first data by the first processor. Therefore, Peinado does not disclose or even suggest the feature of *transmitting a check result to the first processor, the check result being a positive or a negative check result* as provided for in the context of claim 22.

The Serkowski reference merely refers to protecting actuation of features and software within a telecommunication switching system by periodically sending an encrypted message to a license server to request permission to run the controlled application and to obtain a list of permitted features (*see Serkowski*, column 2, lines 5 to 7). The cited text makes it plain that “[t]he license server application is executing on the same processor as the controlled application” (*see id.* at lines 7 to 9). Naturally, Serkowski cannot transmit a check result to the first processor (from the second processor) because there is only one processor. As explained below, Serkowski teaches away from a system of a client computer and a license computer.

Therefore, Peinado and Serkowski do not disclose (or even suggest) all of the features of claim 22, including the feature of *transmitting a check result to the first processor (from the second processor), the check result being a positive or a negative check result*. This is because Serkowski does not disclose a second processor (and therefore, cannot transmit a check result to the first processor from the second one). As explained above, Peinado does not disclose transmitting a check result to the first processor, the check result being a positive or a negative check result¹.

Finally, Serkowski plainly teaches away from its combination with Peinado, since Serkowski concerns protecting actuation of features and software within a telecommunication switching system, in which the controlled application and the license

¹ The Office Action admits that Peinado does not transmit a check result that can be negative.

server application run on the same or a single processor. Moreover, Serkowski refers to a prior art computer that automatically connects to a remote server to receive a machine-specific key (*see* Serkowski, column 1, lines 54 to 68), which is similar to Peinado since both include a content server and a license server from which the content server receives a license. However, Serkowski plainly teaches away from Peinado by specifically stating that the prior art method that uses a content server and a license server, “does not function well for a telecommunication switching system²” as that of the Serkowski reference. In particular, Serkowski sought to depart from the prior art by using a method where the license server application is executing on the same processor as the controlled application (*see* Serkowski, column 2, lines 3 to 8). Therefore, Serkowski specifically adopted a method that has only one processor --which plainly teaches away from the Peinado method.

Accordingly, claim 22 is allowable.

Claims 24, 34, and 41 to 44, as presented, include features similar to those of claim 22, and are therefore allowable for essentially the same reasons as claim 22.

Claims 23, 25 to 33, 35 to 40, and 45 to 48, as presented, depend from claims 22, 24, 34, or 41 to 44, and are therefore allowable for the same reasons.

It is therefore respectfully requested that the obviousness rejections of claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 be withdrawn.

Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Okada, U.S. Patent No. 6,704,872 (Okada).

It is respectfully submitted that even if it were proper to modify the combination of Peinado and Serkowski, as asserted by the Office Action (which is not conceded), Okada does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 25 depends. Accordingly, claim 25 is allowable for at least the same reasons as claim 22, as presented, since Okada does not cure the critical deficiencies of the Peinado and Serkowski references.

² The reasons provided by Serkowski was that the prior art method does not provide for the authorization to use different features of the same software application nor is it dependent on the version of the software being requested. It also does not provide the necessary authorization of personnel to make such a request (*see* Serkowski, col.1, lines 61 to 67). The reason provided evidences that Serkowski preferred a single processor because it would provide the necessary authorization of personnel in one place to make such a request.

Claims 29 and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski.

Since claims 29 and 30 depend on claim 22, claims 29 and 30 are allowable for at least the same reasons as claim 22, as presented.

Claim 35 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Gurr, U.S. Patent No. 4,264,960 (Gurr).

It is respectfully submitted that Gurr does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 35 depends. Accordingly, claim 35 is allowable for at least the same reasons as claim 22, as presented.

Claims 37 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Coley, U.S. Patent No. 5,790,664 (Coley).

It is respectfully submitted that the Coley reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claims 37 and 46 depend. Accordingly, claims 37 and 46 are allowable for at least the same reasons as claim 22, as presented.

Claim 38 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado in view of Serkowski, and in further view of Flick, U.S. Patent No. 6,140,939 (Flick).

It is respectfully submitted that the Flick reference does not cure the critical deficiencies of the combination of Peinado and Serkowski (as explained above) with respect to claim 22 as presented, from which claim 38 depends. Accordingly, claim 38 is allowable for at least the same reasons as claim 22, as presented.

Withdrawal of these obviousness rejections is therefore respectfully requested.

New claim 49 does not add new matter and is supported by the specification. Furthermore, new claim 49 depends from claim 22 and is therefore allowable for at least the same reasons as claim 22.

Accordingly, claims 22 to 46 and 49 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Office Action having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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